

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

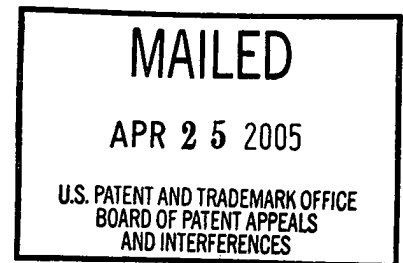
UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte LYNN E. SPITLER and
ANTHONY E. MAIDA, III

Appeal No. 2004-1185
Application No. 09/300,978

REQUEST FOR REHEARING



Before WILLIAM F. SMITH, ADAMS, and GRIMES¹, Administrative Patent Judges.

WILLIAM F. SMITH, Administrative Patent Judge.

ON REQUEST FOR REHEARING

The Board is in receipt of a paper styled "REQUEST FOR REHEARING PURSUANT TO 37 C.F.R. § 1.197(b)" dated February 22, 2005. Therein, appellants request that "the above-identified Patent application be reconsidered in view of the remarks which follow, that each of the presently pending claims be allowed, and that the application be passed to issue." Request, page 1. In addition, the request includes four exhibits denominated Exhibit A - Exhibit D. Id.

We initially note that appellants do not understand that the rules of practice before the Board of Patent Appeals and Interferences were significantly changed

¹ Administrative Patent Judge Winters has retired and Administrative Patent Judge Grimes has been substituted. Note, In re Bose, 772 F.2d 866, 227 USPQ 1 (Fed. Cir. 1985).

effective September 13, 2004. 69 Federal Register 49960-50020 (August 12, 2004).

As of September 13, 2004, 37 CFR § 1.197(b) was revised and is no longer directed toward an appellant requesting rehearing of a Board decision. The appropriate rule in effect as of September 13, 2004, is 37 CFR § 41.52(a)(1) which states in relevant part "[a]rguments not raised in the briefs before the Board and evidence not previously relied upon in the brief and any reply brief(s) are not permitted in the request for rehearing except as permitted by paragraphs (a)(2) and (a)(3) of this section."

Paragraphs (a)(2) and (a)(3) of this section do not allow for admission of Exhibit A - Exhibit D at this point in time in the appeal. Thus, appellants' request for rehearing is improper.

The same result would have been reached if the request for rehearing had been filed at a time when the previous rules of practice before the Board were in effect. Specifically, Exhibit A - Exhibit D would have been considered under the then existing provisions of 37 CFR § 1.195 which provided "[a]ffidavits, declarations, or exhibits submitted after the case has been appealed will not be admitted without a showing of good and sufficient reasons why they were not earlier presented." The request for rehearing dated February 22, 2005, does not include such a showing and thus would have been improper under the old rule.

We have considered the request for rehearing but the arguments presented are intimately tied to and rely upon Exhibit A - Exhibit D and thus are untimely and inappropriate. We do not find that the request for rehearing points to any argument

set forth in the Appeal Brief (Paper No. 30) or the Reply Brief (received November 12, 2000), that we overlooked or misapprehended in reaching our decision of December 22, 2004.

For example, we previously observed appellants agreement that Horoszewicz describes a protocol which employs anti-ids but that appellants believed anti-ids provide a "fundamentally different therapy" than use of an antigen per se. Slip opinion, page 9. We stated that "[i]n making this argument, appellants do not further explain their argument in regard to 'fundamentally different therapy.'" Id., In requesting rehearing, appellants now make arguments that should have been made during the original briefing in this appeal.

If appellants desire the agency to make a new patentability determination based upon the newly proffered evidence, the proper procedure is for appellants to place the case back before the examiner with the new evidentiary record.

The request for rehearing is denied.

DENIED


William F. Smith

Administrative Patent Judge


Donald E. Adams

Administrative Patent Judge


Eric Grimes

Administrative Patent Judge

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